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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,047	12/27/2001	David E. Winn	FED0013	3243
832	7590	08/03/2004	EXAMINER SAVAGE, MATTHEW O	
BAKER & DANIELS 111 E. WAYNE STREET SUITE 800 FORT WAYNE, IN 46802			ART UNIT 1724	PAPER NUMBER

DATE MAILED: 08/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/035,047	WINN ET AL. <i>eh</i>
	Examiner Matthew O Savage	Art Unit 1724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 17 May 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,4,13,15 and 18 is/are rejected.
- 7) Claim(s) 2, 3, 5-12, 14, 16, 17, and 19 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 13, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Hawkins et al.

With respect to claim 1, Hawkins et al disclose a fuel distribution system including a fuel reservoir (see line 27 of col. 1), an electrically operated fuel pump 42 (see FIG. 4), a fluid flow path between the reservoir and an engine (see lines 26-38 of col. 1, and lines 11-22 of col. 2), a fuel filter 23 selectively disposed in the fluid flow path, an electrical conductor (e.g., the constrictive strip disclosed on lines 1-5 of col. 7), for selectively closing the electrical circuit of the pump to allow operation thereof (see from line 51 of col. 6 to line 9 of col. 7), the electrical conductor having an inoperative position (when the filter is removed) and an operative position (when the filter is installed), the electrical circuit of the fuel pump being closed when the electrical conductor is in the operative position, the electrical conductor maintaining the operative position when the fuel filter is

disposed in the fluid flow path, the electrical conductors maintaining the inoperative position when the fuel filter is removed from the fluid flow path.

With respect to claim 13, Hawkins et al disclose an apparatus including a fuel tank, an electrically operated fuel pump 42 having a housing and an electrical circuit (see FIG. 4), a fluid filter 23 selectively disposed in the fluid flow path, and electrically conductive means (see from line 51 of col. 6 to line 9 of col. 7) for selectively closing an electrical circuit of the pump to allow operation thereof, the conductive means closing the electrical circuit of the pump when the fuel filter is disposed in the fluid flow path. This claim has been treated as not having invoked the constraints of 35 U.S.C. 112, sixth paragraph since dependent claim 12 further structurally defines the means.

With respect to claim 18, Hawkins et al disclose a method of preventing non-filtered fuel from reaching an engine when a fuel filter is not operatively positioned in a fluid flow path upstream from the engine (see lines 26-29 of col. 1 and lines 11-22 of col. 2) including providing an electrically operated fuel pump 42 having an open electrical circuit (e.g., when the filter is removed), providing an electrical conductor (e.g., the conductive strip described on lines 1-5 of col. 7) movable to complete the electrical circuit, the electrical conductor moved into position to complete the electrical circuit when the fuel filter is operatively positioned in the fluid flow path.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins et al in view of Pringham.

With respect to claims 4 and 15, Hawkins et al disclose the fuel pump as including a fuel pump housing (see FIG. 4) but fails to specify the fuel pump as being grounded to the housing. Pringham discloses that it is known to ground fuel pump to a fuel pump housing (see the drawing Figure) and suggests that such an arrangement simplifies construction of the electrical circuit. It would have been obvious to have modified the filter of Hawkins so as to have included a pump grounded to a fuel pump housing in order to simplify construction of the electrical circuit.

Claims 7 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins et al.

With respect to claim 7, Hawkins et al disclose an apparatus for preventing non-filtered fuel from reaching an engine connected via a fluid flow path to a fuel tank (see lines 26-37 of col. 1 and lines 11-22 of col. 2) including an electrically operated fuel pump 42 disposed in the fluid flow path, the pump being in fluid communication with the fuel tank and engine, the pump having a housing (see FIG. 4), a fuel filter 23 selectively disposed in the fluid flow path, the filter in

fluid communication with the fuel tank, the pump, and the engine, the fuel filter being positioned upstream of the engine, an electrical conductor (e.g., the constrictive strip disclosed on lines 1-5 of col. 7) (see from line 51 of col. 6 to line 9 of col. 7), the electrical conductor having an inoperative position (when the filter is removed) and an operative position (when the filter is installed), the electrical conductor maintaining the operative position when the fuel filter is disposed in the fluid flow path, the electrical conductors maintaining the inoperative position when the fuel filter is removed from the fluid flow path. Hawkins fails to specify the electrical connector as being connected to ground such that the electrical conductor grounds the fuel pump in the operative position, however, such a modification is not considered patentable since the shifting of position of the ground or power lead with respect to the electrical conductor would not significantly modify the operation of the device (see *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950)).

Regarding claim 11, Hawkins et al disclose a filter housing 21 sized to accommodate the fuel filter and fuel pump, wherein insertion of the filter into the filter housing actuates the electrical conductor into the operative position, and wherein removal of the filter allows the electrical conductor to return to the inoperative position (see from line 49 of col. 6 to line 9 of col. 7).

Claims 2, 3, 5, 6, 8-10, 12, and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 14, 16, and 17 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The declarations filed on 11-24-03 and 5-17-04 under 37 CFR 1.131 have been considered but are ineffective to overcome the Hawkins et al reference because:

The Declaration filed on 5-17-04 is not acceptable since it has not been made by both of the inventors and because a petition under 37 CFR 1.47 has not been granted.

No evidence has been submitted to establish diligence from the date of conception of the instant invention (1-8-99) to a date prior to the date of reduction to practice of the Hawkins et al reference (5-10-00) to either a constructive reduction to practice or an actual reduction to practice.

No evidence has been submitted with the declarations filed on 11-24-03 and 5-17-04 to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Hawkins et al reference.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew O Savage whose telephone number is (571) 272-1146. The examiner can normally be reached on Monday-Friday, 7:00am-3:30pm.

Art Unit: 1724

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on (571) 272-1166. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Matthew O Savage
Primary Examiner
Art Unit 1724

mos
July 31, 2004